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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/532,034

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Jay H. Connolly

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04/20/2006

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/532,034	<b>Applicant(s)</b> CONNELLY, JAY H.	
	<b>Examiner</b> Douglas B. Blair	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-12,14-19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-12,14-19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/2006</u> | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/9/2006 has been entered.
2. Claims 1-2, 4-8, 10-12, 14-19, and 21-32 are currently pending in this application.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4-8, 10-12, 14-19 and 21-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-20, and 23-49 of

Art Unit: 2142

U.S. Patent No. 7,020,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the presently examined application appear to be a broader set of claims to the same invention claimed in the 7,020,893 patent.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 24-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant has defined a machine-readable storage media to include non-tangible media such as carrier wave signals (page 10 of the applicant's specification never defines "storage" media, so it is assumed this term still references carrier wave signals.).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-8, 10-12, 14-19, and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,088,722 to Herz et al. in view of U.S. Patent Number 6,357,042 to Srinivasan et al..

Art Unit: 2142

6. Herz teaches the invention as claimed (As in exemplary claim 28) including a system comprising: a broadcast system; and one or more client systems coupled to the broadcast system; wherein the broadcast system is coupled to broadcast meta-data to a plurality of client systems, the meta-data including sets of descriptors and/or attributes describing respective pieces of broadcast programming content from among a plurality of pieces of broadcast programming content up for consideration to be included in a future, yet to be scheduled, broadcast (col. 12, lines 26-48 and col. 14, lines 24-64); wherein the plurality of client systems are coupled to rate in response to a content rating table one or more of the plurality of pieces of broadcast programming content described by the meta-data, the content rating table generated using the meta-data and containing ratings derived from observations of data pieces of broadcast programming content having similar descriptors and/or attributes to the descriptors and/or attributes included in the meta-data that have been previously accessed via that client system (col. 12, lines 26-48 and col. 14, lines 24-64); wherein the one or more client systems are coupled to transmit to the broadcast system the ratings of the plurality of pieces of broadcast programming content (col. 14, lines 17-23); wherein the broadcast system is coupled to select a portion of the plurality of pieces of broadcast programming content in response to the ratings received for the plurality of client systems (col. 22, line 64-col. 23, line 38); and wherein the broadcast system is further coupled to broadcast the selected portion of the plurality of pieces of broadcast programming content (col. 22, line 64-col. 23, line 38); however Herz does not explicitly teach **broadcasting** meta-data to the client in order to rate content.

Srinivasan teaches the concept of broadcasting meta-data in video data stream (col. 20, lines 15-53).

Art Unit: 2142

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Herz regarding the scheduling of data in a broadcast system with the teachings of Srinivasan regarding the concept of broadcasting meta-data in a video stream because Herz already teaches broadcasting so the teachings of Srinivasan provide a way for Herz to deliver information to set top boxes without having to modify the concepts taught by Herz.

7. As to claims 2, 15, and 25, Herz teaches a machine readable medium and method wherein the selected portion of the plurality of pieces of broadcast programming content that are broadcast are pieces of broadcast programming content having higher content ratings than a remaining portion of pieces of broadcast content that are not selected (col. 22, line 64-col. 23, line 38).

8. As to claims 4, 12, 16, and 23, Herz teaches a system able to receive a broadcast schedule of the second plurality of pieces of broadcast programming content prior to selectively receiving the portion of the second plurality of pieces of broadcast programming content (col. 47, lines 9-30).

9. As to claims 5 and 17, Herz teaches a system able to broadcast a broadcast schedule of the meta-data prior to broadcasting the meta-data to the plurality of client systems (col. 47, lines 9-30).

10. As to claim 6, Herz teaches a method wherein broadcasting the selected portion of the plurality of pieces of broadcast programming content to the plurality of client systems comprises broadcasting one of the plurality of pieces of broadcast programming content having a higher

Art Unit: 2142

rating prior to broadcasting one of the plurality of pieces of broadcast programming content having a lower rating (col. 22, line 64-col. 23, line 38).

11. As to claims 8, 11, 19, 22, and 27, Herz teaches receiving a meta-data broadcast schedule broadcast by the server system, the client system activated in response to the meta-data broadcast schedule (col. 47, lines 9-30).

12. As to claims 29-32, Herz teaches a system wherein each of the plurality client systems is coupled to selectively receive and store a portion of the selected portion of the plurality of pieces of broadcast programming content in response to a content rating table associated with each respective one of the plurality of client systems (col. 47, lines 9-30).

### ***Response to Arguments***

13. Applicant's arguments filed 2/9/2006 have been fully considered but they are not fully persuasive. The applicant is arguing features that are not relied upon by the examiner as pointed out in the Final Rejection mailed on 12/29/2005. Any further response to the rejections present in this office action should address the examiner's interpretation of the references as reiterated below.

14. Herz teaches the a system for sending a questionnaire to customers in order to obtain a customer profile which is then used to schedule future broadcasts of programs (col. 13, lines 25-28). The questionnaire is considered meta-data because it describes the types of programs that will potentially be broadcast. The customers' response to the questionnaires is considered a content rating. The applicant's claim language is not specific to the form of the meta data nor

Art Unit: 2142

the content rating returned by the client, so therefore Herz can be interpreted to read on the applicant's claimed invention.

15. It is logical to combine Herz with Srinivasan because Herz does not explicitly say anything about how the questionnaires are sent to the customers. Broadcasting the questionnaires would be a logical delivery method because the system of Herz is already broadcasting the program data. Srinivasan shows that the concept of broadcasting meta-data along with program data was a well known concept even if it was not explicitly mentioned by Herz.

16. The rejection based on U.S.C. section 101 is maintained because mediums defined as potentially being carrier waves are non-statutory.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

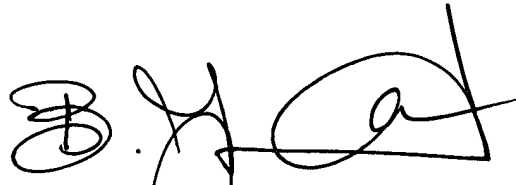


Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

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